

Notice of Allowability

Application No.

10/643,002

Examiner

Milap Shah

Applicant(s)

STROM, MARK ANTHONY

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to requested for continued examination filed 9/7/07.
2. ☒ The allowed claim(s) is/are 1-15.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>20070913</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

DETAILED ACTION

CONTINUED EXAMINATION UNDER 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on September 7, 2007 has been entered.

ELECTION/RESTRICTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to a game on a gaming machine where the symbols of the game include at least two different characteristics that are selected independently, further, additional awards on top of base awards are provided for a predetermined order of the different characteristics, classified in class 463, subclass 20.
- II. Claims 16-20, drawn to a poker type game having the rank and/or suit of the cards in play to be independently selected, further, awards are based on fewer than all of the cards being in a predetermined order (variation of invention I), classified in class 463, subclass 13.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as

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claimed does not require the particulars of the subcombination as claimed because it appears that a player playing a game of Invention I obtains an award for specific generic or subgeneric characteristics being in a specific order, rather than requiring the specific order to have both characteristics for the prize. The subcombination has separate utility such as providing a game in which fewer than all symbols displayed on the screen having multiple characteristics contribute to a prize, where it appears Invention II does not analyze the multiple characteristics separately such as Invention II. Invention II could be usable with Invention I or separately.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

A telephone call was made to Mark Litman on September 13, 2007 to request an oral election to the above restriction requirement, which resulted in an election without traverse of Invention I (claims 1-15). Further, the Applicant requested to cancel claims 16-20 of the non-elected Invention by Examiner's Amendment. This is shown in the Examiner's Amendment below.

DRAWINGS

The drawings were received on September 7, 2007. These drawings are accepted.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mark Litman on September 13, 2007.

The Application has been amended as follows:

In the SPECIFICATION

Title: change the title of the invention to "GAMING SYSTEM WITH MULTIPLE GENERIC AND SUBGENERIC CHARACTERISTICS"

In the CLAIMS

Cancellation of Claims: CANCEL claims 16-20.

Claims 1-15: replace the entire claim listing of claims 1-15 with the following claims:

1. A method of playing a wagering game comprising:
 - a player placing a wager in a wagering machine having a processor;
 - the wagering machine displaying at least a single payline of multiple symbols, the multiple symbols having a predetermined indication of order;
 - the processor independently selecting one of a plurality of generic characteristics for each of the multiple symbols and independently selecting one of a plurality of separate subgeneric characteristics for each of the multiple symbols;
 - the processor determining from the displayed generic characteristics of the multiple symbols alone on the payline whether the symbols have at least one of at least two available predetermined orders of the selected generic characteristics that are associated with a first award; and
 - providing the player with an additional award when the determined at least one of

the at least two available predetermined orders of generic characteristics includes a predetermined order of the selected separate subgeneric characteristics.

2. The method of claim 1 wherein the generic characteristics determined for the multiple symbols comprise playing card suit symbols also have rank symbol modifiers that distinguish like generic characteristics determined for the multiple symbols into subsets, and at least one event consisting of fewer than all of the multiple symbols on a single payline having a same generic characteristic as well as all of the multiple symbols on the single payline having the same generic characteristic symbol will assure the first award on the wager.

3. The method of claim 1 wherein increased awards above the first award are provided when the subgeneric characteristics of playing card ranks appear in a predetermined order of ranks.

4. The method of claim 2 wherein increased awards above the first award are provided when the subgeneric characteristics of playing card ranks appear in a predetermined order of ranks.

5. The method of claim 3 wherein awards vary in amount with respect to at least one predetermined order of subgeneric characteristics with one generic characteristic present in a set of symbols as compared to a same at least one other predetermined order of subgeneric characteristics with a second and different generic characteristic present in the set of symbols.

6. The method of claim 4 wherein awards vary in amount with respect to at least one predetermined order of subgeneric characteristics with one generic characteristic present in a set of symbols as compared to a same at least one other predetermined order of subgeneric characteristics with a second and different generic characteristic present in the set of symbols.

7. The method of claim 3 wherein the at least two predetermined orders of characteristics comprise orders other than Royal Flushes with card symbols in ascending or descending order.

8. The method of claim 4 wherein the at least two predetermined orders of characteristics comprise orders other than Royal Flushes with card symbols in ascending or descending order.

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9. The method of claim 5 wherein the at least two predetermined orders of characteristics comprise orders other than Royal Flushes with card symbols in ascending or descending order.

10. The method of claim 6 wherein the at least two predetermined orders of characteristics comprise orders other than Royal Flushes with card symbols in ascending or descending order.

11. The method of claim 5 wherein each frame in the at least one payline having a number of frames has a number of subgeneric characteristics available, exclusive of blank spaces, that is equal to the number of frames in the payline.

12. The method of claim 5 wherein each frame in the at least one payline having a number of frames has a number of subgeneric characteristics available, exclusive of blank spaces, that is equal to the number of frames in the payline, and the number of frames on a payline is five, and the subgeneric characteristics available consist of Aces, Kings, Queens, Jacks and Tens.

13. The method of claim 5 wherein at least two predetermined orders in a five frame payline that are payouts are selected from the group consisting of:

A-K-Q;

A-K-Q-J;

Q-K-A;

J-Q-K-A;

A-K; and

K-A.

14. A gaming apparatus for playing a computer based wagering game comprising:

a housing;

a processor;

a symbol display area; and

user interface capacity;

wherein the processor is programmed to randomly provide symbols on at least one payline, the processor executing a program to perform a method comprising:

a player placing a wager in a wagering machine having a processor;

the wagering machine displaying at least a single payline of multiple symbols, the

multiple symbols having a predetermined indication of order;

the processor independently selecting one of a plurality of generic characteristics for each of the multiple symbols and independently selecting one of a plurality of separate subgeneric characteristics for each of the multiple symbols;

the processor determining from the displayed generic characteristics of the multiple symbols alone on the payline whether the symbols have at least one of at least two available predetermined orders of the selected generic characteristics that are associated with an award;

providing the player with an additional award when the determined at least one of the at least two available predetermined orders of generic characteristics includes a predetermined order of the selected separate subgeneric characteristics; and

wherein the generic characteristics determined for the multiple symbols comprise playing card suit symbols also have rank symbol modifiers that distinguish like generic characteristics determined for the multiple symbols into subsets, and at least one event consisting of fewer than all of the multiple symbols on a single payline having a same generic characteristic as well as all of the multiple symbols on the single payline having the same generic characteristic symbol will assure a first award on the wager.

15. The apparatus of claim 14 wherein the generic characteristics shown on the multiple symbols also have subgeneric characteristic symbol modifiers that distinguish symbols having a same generic characteristic into subsets and programming requires that the at least two different predetermined orders of subgeneric characteristics also have same generic characteristic symbol modifiers.

REASONS FOR ALLOWANCE

Claims 1-15 are allowed.

The following is an Examiner's statement of reasons for allowance. A thorough search of prior art fails to disclose any reference or references, which, taken alone or in combination teach or suggest, in combination with the other limitations, "providing the player with an additional award when the determined at least one of the at least two available predetermined orders of generic

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characteristics includes a predetermined order of the selected separate subgeneric characteristics". When this limitation is recited in combination with "the processor independently selecting one of a plurality of generic characteristics for each of the multiple symbols and independently selecting one of a plurality of separate subgeneric characteristics for each of the multiple symbols" the prior art fails to read on the claimed invention.

The closest prior art is a combination of Walker et al. & Inoue as discussed in the Final Action mailed May 7, 2007. Walker teaches a substantial portion of the invention and Inoue was used to remedy the limitations that Walker lacked including the processor independently selecting two different characteristics of one of the symbols on a payline. Further, the Applicant has added that a second or additional payout is granted based on the game determining that a predetermined order of one of the characteristics exists and then determining if that predetermined order further includes a predetermined order of a second characteristic. Thus, a two step process is carried out. This process appears to be missing from the prior art and it would not have been obvious to modify the combination of Walker et al. & Inoue, as Inoue is simply a game having a reel that comprises of two independent reels and Walker makes no indication to determine an order of two different characteristics of a single symbol. For at least these reasons, claims 1-15 are allowed.

CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert Pezzuto
Supervisory Patent Examiner
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MB.S.